

PRE-APPEAL BRIEF REQUEST REVIEW

Sir/Madam:

In consideration with the Pre-Appeal Brief Request of January 20, 2009, please consider the attached proposed claim amendment and comments regarding the above-identified application as follows:

REMARKS/ARGUMENTS

1. Amendments to the Claims

Claim 1 illustrates a proposed amendment for this application. Applicants respectfully request reconsideration in light of this proposed amendment and the following comments.

1. (Currently Amended) A fibrous web ~~containing~~ comprising:
an amount of solids, wherein solids include fibrous material, and a filler, wherein the filler is a substance in a granular form, having a rotationally symmetrical shape and an inner part and a crust part, whereby the density of the inner part is lower than the crust part, wherein the density of the inner part is about 10 to 90% of that of the crust part, and the amount of filler used is ~~3~~ within the range of approximately 30 to approximately 60% of ~~an~~ the amount of solids.

In the Response to Applicant's Arguments, the Examiner clarified the rejection and repeatedly stated that it is unclear whether or not "an amount of solids" is within or not within the claimed invention. The following summation by the Examiner is exemplary: "[t]herefore, it is unclear how the expression or format of the claim makes clear the boundaries of the subject matter since the claims, as presently constructed, do not appear to have any boundaries, thus rendering the claim infinite." In light of the Examiner's clarification, Applicants have proposed this amendment to claim 1 to expressly include "an amount of solids" as a claim limitation. If amendment is approved, this amendment would provide a basis for allowance or a simplification of the issues on appeal.

2. Rejections under 35 U.S.C. § 112

Applicants respectfully request the reviewers to consider the Applicants' arguments of Amendment dated June 18, 2008 in response to the Office Action dated January 18, 2008. Applicants respectfully submit that the Examiner has failed to take note of Applicants' arguments and has failed to answer the substance of Applicants' arguments.

Pursuant to MPEP § 707.07(f): where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Pursuant to MPEP § 2145: Office personnel should consider all rebuttal arguments and evidence presented by applicants. Applicants respectfully submit that Examiner take note of Applicants' arguments, state that the Examiner has considered Applicants' specific arguments, and answer the substance of each argument.

A. "Solids"

Applicants respectfully submit that the amount of solids is clear. Applicants respectfully directed the Examiner to paragraphs [0036] and [0037] of Published Patent Application Number 2005/0116010 A1 (page 6, lines 5-16 of the Specification as Filed under PCT/FI03/00229). This portion of the specification ends with the following:

[0037] . . . Typically, the fibrous pulp contains 95% of water, and the amounts of fibre and additive are in the same proportion than in the finished fibrous product. Thus, 40 to 90% of the amount of solids is fibrous material, and 10 to 60% are additives and auxiliary substances (containing fillers).

Pursuant to MPEP § 2173.01, Applicants may use any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. The above referenced portion of the specification clearly stated that the structure includes fibrous material, additives and auxiliary substances containing fillers, all of which would be understood as "solids" by one of ordinary skill in the art. This portion of the specification clearly stated the amount of solids. This portion of the specification detailed the amount of solids, the relationship between granulated filler and the other fillers, and the relationship of the amount of solids to the rest of the fibrous pulp. Applicants respectfully submitted that the § 112, second paragraph rejection based on the structure or amount of solids was no longer appropriate and requested withdrawal.

The Examiner continued to recite past arguments stating that the claims do not set forth any structure or amount of solids. Applicants respectfully remind the Examiner that "[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and

particularity.” MPEP § 2173.02. Furthermore, under MPEP § 2173.04: if the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. Applicants’ conclude that based on the proper test for indefiniteness, it is not *per se* necessary to state the structure or amount of solids in the claim.

Applicants respectfully request that the Examiner note the terms which have been challenged as indefinite within MPEP § 2173. Applicants respectfully note that new terms, terms contrary to their ordinary meaning, relative terms, amount limitations, and exemplary language are the types of terms challenged under 35 U.S.C. 112, second paragraph under indefiniteness. See MPEP § 2173.05(a-d). Applicants also note that terms used with their ordinary meaning, such as “solids,” are not challenged as indefinite. Terms used with their ordinary meaning set out and circumscribe particular subject matter with a reasonable degree of clarity and particularity.

Regarding the following statement by the Examiner: “As presently constructed, conceivably any solid could be used as a standard to which to compare the amount of filler.” Applicants respectfully remind the Examiner of MPEP § 2173.04: Breadth is Not Indefiniteness:

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). . . .

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad.

Applicants respectfully remind the Examiner that the “conceivably any solid” statement is not a proper basis for an indefiniteness rejection.

B. “Fine” and Flexible”

The subject matter of Applicants’ Response of June 18, 2008 is shown below:

The Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite due to the recitation of “fine” and “flexible.” Applicants respectfully submit that the specification need not disclose how to measure a degree of fineness or a degree of flexibility associated with the recitation. Pursuant to MPEP § 2164.01, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). Applicants respectfully submit that the method of measuring fine and flexible

associated with the recitation are well known in the art. Applicants respectfully submit that the § 112, second paragraph rejection is no longer appropriate and should be withdrawn. Applicants respectfully submit that the claim is definite.

In the current Office Action dated July 18, 2008 under the section titled Response to Applicants' arguments, the Examiner failed to cite Applicant's arguments and recited previous arguments. The Examiner adds that the claim is indefinite because it is unclear what is intended by a "fine and flexible coat." Applicants respectfully submit that the Examiner has failed to take note of Applicants' arguments and has failed to answer the substance of Applicants' arguments.

Furthermore, Applicants respectfully remind the Examiner to provide some latitude in the manner of expression and the aptness of terms. Pursuant to MPEP § 2173.02:

Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Applicants respectfully submit that the Examiner has failed to provide latitude in the manner of expression and the aptness of terms. Applicants also expressly request that the reviewers suggest claim language to improve the clarity or precision of the language used.

3. Rejections under 35 U.S.C. § 102/103

Applicants respectfully request the reviewers to consider the Applicants' arguments of Amendment dated June 18, 2008 to the Office Action dated January 18, 2008. Applicants respectfully submit that the Examiner has failed to take note of Applicants' arguments and has failed to answer the substance of Applicants' arguments. Pursuant to MPEP § 707.07(f): where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Pursuant to MPEP § 2145: Office personnel should consider all rebuttal arguments and evidence presented by applicants. Applicants respectfully submit that Examiner take note of Applicants' arguments, state that the Examiner has considered Applicants' specific arguments, and answer the substance of each argument.

Specifically consider that the Examiner previously stated that "Grönroos does not appear to specifically teach that the amount of filler used is 3 to 60% of an amount of solids and 30% to 60% of the amount of solids." Emphasis added. The Examiner also fails to cite a single reference

in Grönroos to support the recitations of claims 1 and 25. Applicants respectfully submit that Examiner's own statement that Grönroos does not appear to specifically teach a claim recitation of independent claim 1 and dependent claim 25 means that under Grönroos cannot anticipate claims 1-13 and 25. Applicants respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102 rejection.

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2142. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Applicants respectfully submit that Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner states that the limitation is unclear as the claims attempt to compare the amount of filler as a percentage against an amount of solids, without providing a proper standard as to what amount of solids, if any, are present in the claimed invention. As set forth above, applicants respectfully submit that the amount of solids is clear. Applicants have already directed Examiner to portions of the specification detailing the structure and amount of solids. Furthermore, a claim limitation which is considered indefinite cannot be disregarded. MPEP § 2143.03.

If, however, the examiner still concludes that a *prima facie* case has been made, the burden of coming forward with evidence or arguments shifts to the applicants who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. MPEP 2142. Applicants respectfully submit that the application as filed includes comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.

4. Conclusion

Applicants respectfully request that the reviewers consider Applicants' arguments. Applicants respectfully request a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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